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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,729	12/29/2003	Frederick J. Kiko	EXCEL.016REC1	1310

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GAZDZINSKI & ASSOCIATES
11440 WEST BERNARDO COURT, SUITE 375
SAN DIEGO, CA 92127

EXAMINER

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 08/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,729	Applicant(s) KIKO, FREDERICK J.	
	Examiner BINH K. TIEU	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

2. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest *in order to support the consent to a reissue application required by 37 CFR 1.172(a)*. The submission establishing the ownership interest of the assignee is informal. There is no indication of record that the party who signed the submission is an appropriate party to sign on behalf of the assignee. 37 CFR 3.73(b).

A proper submission establishing ownership interest in the patent, pursuant to 37 CFR 1.172(a), is required in response to this action. For example:

According to 37 CFR 1.172(a) and 3.73 above, the submission (ESTABLISHMENT OF RIGHT OF ASSIGNEE TO TAKE ACTION AND REVOCATION AND POWER OF ATTORNEY dated on 08/21/03 provided by Applicant) shows that the person (President of EXCEL TECHNOLOGIES, INC.: Mr. Alan Benjamin) signing the submission is a person authorized to act on behalf of the assignee. But the Applicant fails to include a statement that

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the person (Mr.: Alan Benjamin) signing the submission is authorized to act on behalf of the assignee. In the other words, a signal statement identifying the assignee to establish ownership is missing. As the results, a review of the reissue application did not result in a written consent statement from the Assignee.

3. The reissue oath/declaration filed with this application is defective because the error, which is relied upon to support, the reissue application is not an error upon which a reissue can be based. The error statement is not specific enough, See 37 CFR 1.175(a)(1) and MPEP § 1414.

4. The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414.

5. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 18-40 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

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“Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant.”

6. A review of the record does not reveal either the statement or actual surrender of the original Patent, or a statement as to its loss or inaccessibility. Surrender of the Patent or statement of loss is required before the application can issue.

Response to Amendment

7. A review of the Application along with Preliminary Amendment filed on 12/29/2003, it is recognized that the preliminary amendment is filed in the format of regular applications, not in reissue applications. It does not comply with 37 CFR 1.173, for example:

A/ In reissue applications, anything that is deleted from the original Patent is bracketed, not cross out. For example, The Preliminary Amendment was not performed correctly. The cancellation of the original claims 1-17 should have resulted in the original claims being bracketed rather than being crossed out.

The contents of original claims 1-17 should be rewritten in a pair of bracketed, not similarly said “1-17 [Cancelled]”

B/. Anything added to the original Patent is underlined.

C/. Amendments to the specification other than the claims, must be made by submission of the entire text of an added or rewritten paragraph, 37 CFR 1.173 does not permit for replacement of entire sections of the original specification, i.e., multiple paragraphs or pages.

Double Patenting

8. Claims 18-40 are provisionally rejected under the judicially created doctrine of double patenting over claims 18-34 and 42-60 and 62 of copending Application No. **10/408,030**; and over claims 81-121 of copending Application No. **10/355,897**. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: all sets of claims in the applications of 10/748,729, 10/408,030 and 10/355,897 wherein each set of claims recites the same and/or similar scope of claimed invention: a configuration of telecommunication impedance blocking filter circuit comprising a plurality of inductors connected on each of first and second paths, input terminals, output terminals, first switch connected in series with a capacitor and actuated in response to DC loop current or an off-hook transient, etc., first tank and second tank circuits, compression circuit, etc.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Objections

9. Claim 25 objected to because of the following informalities:

Dependent claim 25 cannot depend on itself. Therefore, for examination purposes, Examiner assumed that it depends on either independent claim 18 or dependent claim 20. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claim 25 recites the limitation "said inductive windings". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Gupta (U.S. Pat. #: 5,025,443).

Regarding claim 36, Gupta teaches a telecommunication impedance blocking filter circuit, as shown in figure 11, comprising:

at least one input terminal (i.e., terminals on the left side of figure 11);

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at least one output terminal (i.e., Tip and Ring terminals connected to telephone 700);

a first filter stage disposed in electrical series between said at least one input and output terminals (i.e., inductor L5A, etc.);

a second filter stage disposed in electrical series with the said first filter stage (i.e., Metallic Low Pass Filter (LPF) 710);

a suppression circuit disposed in electrical series with said first and second filter stages, said suppression circuit being adapted to suppress voltage transients occurring within said filter circuit as the result of an on-hook to off-hook, or off-hook to on-hook, transient (col. 18, lines 11-38).

Regarding claims 37 and 38, note capacitors C5, C6, C7, C15 and inductors L1A, L2A, L1B, L2B of Metallic LPF 710 operative as first tank and second tank circuits in figure 11.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 18-23, 25-33 and 39-40, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (U.S. Pat. #: 5,025,443) in view of Williamson et al. (U.S. Pat. #: 6,477,249).

Regarding claim 18, Gupta teaches a telecommunication impedance blocking filter circuit, as shown in figure 11, comprising:

- at least one input terminal (i.e., terminals on the left side of figure 11);
- at least one output terminal (i.e., Tip and Ring terminals connected to telephone 700);
- a first filter stage disposed in electrical series between said at least one input and output terminals (i.e., inductor L5A);
- a second filter stage disposed in electrical series with the said first filter stage (i.e., Metallic Low Pass Filter (LPF) 710);
- a third filter stage disposed in electrical series with said second filter stage (i.e., L4A).

it should be noticed that Gupta fails to clearly teach said second stage comprising a capacitor and switch disposed in series with one another. However, Williamson teaches such features in figures 12 and 13 for a purpose of turning On/Off a capacitor.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use the second stage comprising a capacitor and switch disposed in series with one another, as taught by Williamson, into view of Gupta in order to reduce the additive capacitance on the telephone loop.

Regarding claim 19, Gupta further teaches a fourth filter stage disposed in electrical series with said third stage, said fourth stage being adapted to reduce return loss (col.18, lines 45-55).

Regarding claim 20, Gupta further teaches said fourth stage comprises R-L-C tank circuit such as R1, R2, T1 and C12 tank circuit.

Regarding claims 21-22, Williamson further teaches limitations of the claim in col.8, lines 48-60.

Regarding claim 23, Williamson further teaches limitations of the claim in col.9, lines 1-4.

Regarding claim 25, Gupta further teaches the T1 coils of C2 as shown in figure 11 operative as inductive windings being disposed in the tank circuit.

Regarding claims 26-28, Gupta further teaches limitations of the claims in figure 11, col.18, lines 11-38.

Regarding claim 29, Gupta teaches a telecommunications filter circuit, as shown in figure 11, comprising:

- first and second input terminals (i.e., terminals on the left side of figure 11);

- first and second output terminals (i.e., Tip and Ring terminals connected to telephone700);

- at least first and second inductors disposed in electrical series between said first input and first output terminals (i.e., inductors L5A, L5B);

- at third and fourth inductors disposed in electrical series with the said second input and second output terminals (i.e., L4A and L4B);

It should be noticed that Gupta fails to clearly teach a capacitor and switch disposed in series with one another. However, Williamson teaches such features in figures 12 and 13 for a purpose of turning On/Off a capacitor.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use the second stage comprising a capacitor and switch

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disposed in series with one another, as taught by Williamson, into view of Gupta in order to reduce the additive capacitance on the telephone loop.

Regarding claim 30, Gupta further teaches fifth and sixth inductors such as the pair of inductors L1A and L1B or L2A and L2B as shown in figure 11.

Regarding claim 31, Gupta further teaches said fifth and sixth inductors are part of respective ones of R-L-C tank circuit such as R1, C5, L1A or L2A tank circuit, or R-L-C tank circuit such as R2, C6, L1B or L2B tank circuit, as shown in figure 11.

Regarding claims 32-33, Williamson further teaches limitations of the claim in col.8, lines 48-60.

Regarding claim 39, Gupta teaches a telecommunications circuit, as shown in figure 11, comprising:

first and second circuit paths disposed substantially in electrical parallel to one another between respective sets of input and output terminals, said first and second circuit paths each comprising a plurality of inductive elements (i.e., inductors L4A, L1A, L2A and L5A electrically connected in series on first circuit path; and inductors L4B, L1B, L2B and L5B electrically connected in series on second circuit path); and

a suppression circuit disposed in electrical series with said first and second filter stages, said suppression circuit being adapted to suppress voltage transients occurring within said filter circuit as the result of an on-hook to off-hook, or off-hook to on-hook, transient (col.18, lines 11-38).

It should be noticed that Gupta fails to clearly teach a capacitor and switch disposed in series with one another, said switch and capacitor being disposed between said first and second

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circuit paths. However, Williamson teaches such features in figures 12 and 13 , col.8, line 48-67 for a purpose of changing subscriber loop.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use the second stage comprising a capacitor and switch disposed in series with one another, as taught by Williamson, into view of Gupta in order to reduce the additive capacitance on the telephone loop.

Regarding claim 40, Gupta teaches a telecommunications circuit, as shown in figure 11, comprising:

first and second circuit paths disposed substantially in electrical parallel to one another between respective sets of input and output terminals, said first and second circuit paths each comprising a plurality of inductive elements (i.e., inductors L4A, L1A, L2A and L5A electrically connected in series on first circuit path; and inductors L4B, L1B, L2B and L5B electrically connected in series on second circuit path); and

It should be noticed that Gupta fails to clearly teach a capacitor and switch disposed in series with one another, said switch and capacitor being disposed between said first and second circuit paths said switch being responsive to DC loop current generated within said first circuit when a device connected thereto goes off-hook. However, Williamson teaches such features in figures 12 and 13, col.8, line 48-67 for a purpose of controlling impedance of subscriber loop.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use the second stage comprising a capacitor and switch disposed in series with one another, as taught by Williamson, into view of Gupta in order to reduce the additive capacitance on the telephone loop.

16. Claims 24 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta (U.S. Pat. #: 5,025,443) in view of Williamson et al. (U.S. Pat. #: 6,477,249) as applied to claim 18 above, and further in view of Bingel (U.S. Pat. #: 5,848,150).

Regarding claims 24 and 34, Gupta and Williamson, in combination, teaches all subject matter as claimed above, except for a second switch disposed within one of the said first, second, third filter stage. However, Bingel teaches a signals filter arrangement as shown in figure 1 comprising first, second, third stage, etc. Bingel further teaches diodes D1-D2 disposed within one of the filter stages operating as first and second switches (col.4, line 56 – col.5, line 37) for a purpose of controlling DC current flowing through subscriber line.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of said diodes D1-D2 operative as first and second switches, as taught by Bingel, into view of Gupta and Williamson, in order to control DC current flowing through the subscriber loop.

Regarding claim 35, Bingel further teaches limitations of the claim in figure 6.

Response to Arguments

17. Applicant's arguments filed in remarks of the preliminary amendment on page 8 have been fully considered but they are not persuasive.

In response to the Applicant's arguments stated in the last paragraph, page 8 wherein the Applicant stated as followings:

“...Williamson in no way teaches or suggests actuating the switch in response to DC loop current, such as e.g., would occur entering the “off-hook” state; Williamson closes the switch for a very different purpose.”

The Examiner respectfully disagrees with the Application arguments as stated above. Williamson, first, defined the term “amplitude” as “voltage or current” (see column 3, lines 41-43). Williamson further defined the terms “loop-disconnect signaling” and/or “loop-disconnect dialing” when a telephone signals a DTMF signal, receives a ringing tone or goes off-hook that causes sudden changes in high or low voltage of subscriber telephone line. Such telephone signaling generates high frequency component or called “high amplitude signaling” (see column 5, lines 38-59). Williamson further teaches in column 8, lines 55-58 that *“...During high amplitude signaling switch SW closes and the filter comprises relay coil RL and parallel combination of capacitors C1 and C2...”* Thus, it is clearly understood that the switch SW is closed if the telephone is in one of conditions: going off-hook, receiving a ringing tone, or generating or dialing a DTMF signal.

With all the remarks in response to the Applicant’s arguments as stated above, the Examiner believes that Williamson teaches the switch SW is actuated in response to changing of DC loop current or voltage during off-hook condition of a telephone device. Therefore, the Examiner has maintained the same rejection as set forth in the Application 10/408,030 to be applied into rejections of independent claims 18, 29 and their dependent claims in this Office Action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

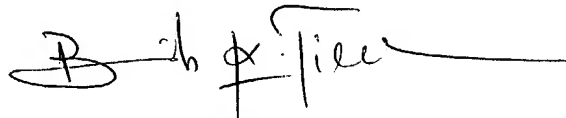
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Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

A handwritten signature in black ink, appearing to read 'Binh Tieu', with a long horizontal line extending to the right.

BINH TIEU
PRIMARY EXAMINER

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Date: July 28, 2004